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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,775	12/22/2000	Weijun Li	031994-170	4406

7590 10/28/2004

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/747,775

Applicant(s)

LI, WEIJUN

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

### Response To Applicant's Amendments

Claims 1-15, 16-29 and 30-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1, 16 and 30 contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Indeed, claims 1, 16 and 30 introduce the following new matter-

“providing said electronic content to an executable program adapted to read said electronic content, said electronic content having associated therewith a user right, **said user right being either a restricted right or an unrestricted right to be provided said electronic content;**”

“determining **if said user right is a restricted right or an unrestricted right;**”

“**if said user right is a restricted right**, invoking an executable module attached to said executable program to obtain at least one electronic advertisement;”

“**presenting said at least one electronic advertisement to said user and providing said electronic content to said user**”

“**if said user right is an unrestricted right**, providing said electronic content to said user”.

Here, as shown above in bold, the concept of determining if the user's right is restricted or unrestricted before deciding whether or not the requested electronic content should be provided to the user with or without an electronic advertisement is not supported in the specification.

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Furthermore, the amendment to the specification as introduced by new figure 3 (not received by the Examiner) along with its description is not considered because it introduces new matter in the specification.

Therefore, the amendments to the claims and to the specification will not be entered for introducing new matter under 35 U.S.C 112(1).

### **Response to Applicant's Arguments**

In general, Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### **DETAILED ACTION**

#### ***Specification***

The title of the invention is not descriptive so as to help one having ordinary skill in the art understand the nature of the subject matter. A new title is required that is clearly indicative of the invention to which the claims are directed. See 37 CFR 1.72.

On page 5: 1, "callbelongs to" should apparently be - -call belongs to--.

On page 5: 17, "...the a" should apparently be - -...the--.

### ***Drawings***

New corrected drawings are required in this application because appended figs 1 and 2 do not disclose any formal information, which could help the Examiner understand the nature of the subject matter. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Information Disclosure Statement***

The listing or the reference to prior art systems, such as the reference to the InterTrust Technologies Corporation system on page 2: 21-22, in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-15, 16-29 and 30-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1, 16 and 30 contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Indeed, **the concept of determining if the user's right is restricted or unrestricted before deciding whether or not the requested electronic content should be provided to the user with or without an electronic advertisement is not supported in the specification.**

In addition, the Application as originally filed and including original appended claims 1-18 and figs. 1 and 2 (see attached claims and figs) **does not support the concept of providing an advertisement to a user under any conditions.** To this end, claims 1-29, before the present amendment, contain limitations that are supported in the specification and hence, these claims are also rejected under 35 U.S.C 112(1).

No art rejection will be provided here. *✓*

### Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

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For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

10/14/04

A handwritten signature in cursive script, reading "Jonathan Sean Davis". The signature is written in black ink and is positioned below the date "10/14/04".